

### **AMENDMENTS TO THE DRAWINGS**

The attached "Replacement Sheets" of drawings include changes to Figure 10. The attached "Replacement Sheets," which include Figures 10A and 10B, replace the original sheets including Figure 10.

Attachment: Replacement Sheets

### **REMARKS**

Claims 61-71 and 74-87 are now pending in the application. Claims 62, 70, 84 and 85 are currently amended. No claims are newly added or cancelled by this amendment. Support for the foregoing amendment can be found throughout the specification, drawings, and claims as originally filed and as amended. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments and remarks contained herein.

### **DRAWINGS**

The drawings stand objected to for certain informalities. Applicant has attached revised drawings for the Examiner's approval. Figure 10 is now illustrated by Figures 10A and 10B to show the two different embodiments including the features of claims 84 and 85. Figure 10A shows the device in accordance with claim 84 having a polycarbonate outer sheaf. Figure 10B shows the device having a polycarbonate insert member between the device and the front face of the column upright according to claim 85. Applicant has made the appropriate correction, thus rendering the objection moot.

### **SPECIFICATION**

Applicant has amended paragraph [0123] of the specification in order to refer to the features of Figures 10A and 10B. Applicant has also amended paragraph [0012] in order to correct a typographical error.

## **REJECTION UNDER 35 U.S.C. § 112**

Claims 61-71 and 74-87 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point and distinctly claim the subject matter which Applicant regards as the invention. This rejection is respectfully traversed.

The applicant respectfully submits that, contrary to the Examiner's position, the MPEP states that the term "substantially" is not necessarily indefinite. At MPEP 2173.05(D), the term "substantially" is explained as follows:

### ***"D. "Substantially"***

*The term "substantially" is often used in conjunction with another term to describe a particular characteristic of the claimed invention. It is a broad term. In re Nehrenberg, 280 F.2d 161, 126 USPQ 383 (CCPA 1960). The court held that the limitation "to substantially increase the efficiency of the compound as a copper extractant" was definite in view of the general guidelines contained in the specification. In re Mattison, 509 F.2d 563, 184 USPQ 484 (CCPA 1975). The court held that the limitation "which produces substantially equal E and H plane illumination patterns" was definite because one of ordinary skill in the art would know what was meant by "substantially equal." Andrew Corp. v. Gabriel Electronics, 847 F.2d 819, 6 USPQ2d 2010 (Fed. Cir. 1988)."*

The applicant therefore respectfully submits that in this case the term "substantially" is not indefinite.

Furthermore, the applicant respectfully submits that the term "substantially" is included in the claims of the corresponding UK patent GB 2413276 B. According to the Trade Related Aspects of Intellectual Property Rights (TRIPS) Agreement, Annex 1C of the Marrakesh Agreement establishing the World Trade Organization signed on April 15, 1994, the UK Patent Office has found the invention to be new, involve an inventive step, and be capable of industrial application. According to the notes 5 pursuant to

Article 27 TRIPS, the term “inventive step” is deemed to be synonymous with the term “non-obvious”. The applicant respectfully submits that the present invention has passed the test of inventive step in the United Kingdom and urges the Examiner to allow a granted US patent, having regard to the positive decision on patentability of the UK Patent Office. Accordingly, Applicant requests reconsideration and withdrawal of this rejection.

### **REJECTION UNDER 35 U.S.C. § 103**

Claims 61, 63-69, 71, 74, 75-83, 86 and 87 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ian (U.K. Pat. App. GB 2,321,688; “Ian”) in view of Hamilton (U.S. Pat. No. 7,182,993; “Hamilton”). This rejection is respectfully traversed.

Hamilton discloses a table cushioning assembly, the use for which “*for protecting an infant, toddler or child from injuring themselves on the edge of a table or counter top*”. The purpose of the device in Hamilton is to protect an infant from impact with a sharp edge, e.g., a table top.

In contrast, the purpose of the present invention is to prevent a 1- or 2-ton fork lift truck from bashing into the leg of a heavily loaded racking system in a warehouse, which may be up to 30 or 40 feet high and contain tons of material, and to prevent the whole racking system from collapsing with risk of death or injury from the collapse of many tons of goods stored on the racking system.

The applicant respectfully submits that Hamilton is in a completely different field to the present invention, and the skilled person would not think to use the device of Hamilton for protecting a warehouse racking system for the following reasons:

In general, toddlers or infants are not permitted and/or are not commonly seen in warehouses.

In the event that toddlers or infants were permitted in warehouses, and they did inadvertently knock into the leg of a warehouse racking system, they would be unlikely to damage that leg to the extent of buckling the leg.

Humans, toddlers or infants in particular, do not have a mass of several tons, as does mechanical handling equipment such as a fork lift truck having a cast iron counter weight; therefore, the infant is very unlikely to damage the racking system in the same way as an impact from a heavy fork lift truck.

To protect against impact from infants or toddlers in a warehouse would generally require no impact protector at all, but rather the impact is more likely to injure or hurt the child than damage the racking system.

The purpose of the device in Hamilton is to protect infants or toddlers from injury by impact with sharp edges. This is a completely different purpose from that of the impact protector of the present invention.

Hamilton addresses a completely different problem from the problem addressed in the present application. The applicant respectfully requests the Examiner more fully explain the precise relevance of Hamilton.

Moreover, the skilled person would not seek to combine Ian with Hamilton because Hamilton does not teach a protective device for protecting an upright column of a racking system. Hamilton is a protector for stopping children from banging their heads on tables, and has nothing to do with warehouse storage or mechanical handling equipment (MHE) warehouses. Therefore, it is respectfully submitted that these claims

define patentable subject matter over the combination of Ian and Hamilton. Accordingly, Applicant respectfully requests reconsideration and withdrawal of this rejection.

Claim 62 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Ian in view of Hamilton, and further in view of Kreiter (U.S. Pat. No. 5,482,238; "Kreiter"). This rejection is respectfully traversed.

Claim 62 is amended to specify upright edges. Kreiter, figure 6, does not show a cylindrical outer shell. The shell of Kreiter is ovoid. Therefore, it is respectfully submitted that this claim defines patentable subject matter over the combination of Ian, Hamilton, and Kreiter. Accordingly, Applicant respectfully requests reconsideration and withdrawal of this rejection.

Claim 70 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Ian in view of Hamilton, and further in view of Jacoby (U.S. Pat. No. 4,088,229; "Jacoby"). This rejection is respectfully traversed.

The chamfered edge in Jacoby shows a chamfer which declines with respect to the vertical from the leg outwards, whereas in the present application, the chamfer declines inwardly towards the leg, to enable the inner line to slide between the leg and the outer shell. The purpose of the chamfers in Jacoby is simply to prevent personnel injuring themselves or cutting themselves on the metal work. Therefore, it is respectfully submitted that this claim defines patentable subject matter over the combination of Ian, Hamilton and Jacoby. Accordingly, Applicant respectfully requests reconsideration and withdrawal of this rejection.

Claim 84 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Ian in view of Hamilton, and further in view of Molari, Jr. (U.S. Pat. No. Re 32,406 E; "Molari"). This rejection is respectfully traversed.

The purpose of the additional outer sheath is to give a visual indication of whether the column protector has received an impact which will lead to failure of the underlying column support, or risk the failure of the racking system. If the polycarbonate outer sheath receives an impact above a predetermined force, then the polycarbonate outer sheath cracks. Such cracks are easily visible on the outside of the impact protector and serve as an indication for maintenance to replace the column and the impact protector. This permits quick and easy visual inspection where the presence of a crack in the outer sheath denotes that the impact protector and the leg of the racking system must be replaced. There is no teaching, suggestion or motivation of claim 84 contained in Molari, Hamilton, or Ian. Therefore, it is respectfully submitted that this claim defines patentable subject matter over the combination of Ian, Hamilton and Molari. Accordingly, Applicant respectfully requests reconsideration and withdrawal of this rejection.

Claim 85 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Ian in view of Hamilton, and further in view of Consoli (U.S. Pat. No. 5,746,622; "Consoli"). This rejection is respectfully traversed.

Consoli discloses an electrical connector housing for a computer board. The skilled person considering racking systems for storage of goods in warehouses would

not look to the field of computer electronic components in seeking to solve the problem of preventing collapse of warehouse racking systems due to inadvertent impact with mechanical handling equipment.

Contrary to the Examiners assertions, the applicant respectfully submits that Consoli does not teach a polycarbonate insert which is capable of being inserted between the inner liner and the front face of a column, and which is capable of being removed for visual inspection without removing the outer or inner liners. In Consoli, there is no disclosure of inserting the computer component into a rack protector of a warehouse racking system, and it is unreasonable to conceive any circumstance where the skilled person would wish to do so.

It is not clear from either Ian, Hamilton – which refers to a cushion protector for an infant, or Consoli – which refers to an electronic component for a computer board, how or why one would actually insert, or wish to insert, a computer connector between a rack protector and a leg of a warehouse racking system, with the object of using that component to test whether an impact of a dangerous level has occurred on the leg of the warehouse racking system. Using the electrical component embodiments shown in Consoli, such an exercise would be futile because the component is not of the size or shape which would enable it to be slid between the inner member and the leg of the present column protector (see for example figure 10), and in any case even if the component was forced down between the foam and the leg, it could not be slid out and inspected. Therefore, it is respectfully submitted that this claim defines patentable subject matter over the combination of Ian, Hamilton and Consoli. Accordingly, Applicant respectfully requests reconsideration and withdrawal of this rejection.



## **CONCLUSION**

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested.

If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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